

REMARKS

Claims 42 and 43 are pending in the application. Claims 42 and 43 are rejected under 35 USC § 103(a). Remarks comprising arguments directed to the rejection are presented beginning at page 2 of the Response.

Claim rejections: 35 USC § 103

At paragraph 1 of the detailed action the Examiner has rejected claims 42 and 43 under 35 USC § 103(a) as unpatentable over Vogelgesang et al. (US 4,812,633). Applicant respectfully traverses.

Applicant respectfully submits that no *prima facie* case of obviousness has been established. In the recent decision *KSR International v. Teleflex* (No. 4-1350, decided 30 April 2007), the Supreme Court explained that:

Graham v. John Deere Co. of Kansas City, 383 US 1, 17 - 18, set out an objective analysis for applying § 103: "[T]he scope and content of the prior art... are determined; differences between the prior art and the claims at issue are ... ascertained; and the level of ordinary skill in the pertinent art are resolved. Against this background the obviousness or nonobviousness of the [claimed] subject matter is determined."

Applicant respectfully submits that, with the exception of identifying the content of the prior art, i.e., the Vogelgesang reference, the examiner has failed to carry any portion of this burden in stating his rejection. In view of that failure it is not possible for the Examiner to have fairly determined the obviousness or nonobviousness of the claimed subject matter.

The scope and content of the prior art, and differences between the art and the claims at issue

Vogelgesang teaches data cards comprising fenders projecting outwardly from the card and disposed adjacent an outer surface of the recording region for protecting the magneto-optic recording region. (See, e.g., the Abstract.)

Vogelgesang neither teaches nor suggests either:

As recited by Claim 42, a method of forming an optical disc, the method comprising: injection molding a compact disc having a pattern of digital data encoded on a surface having a major elevational portion bounded by

first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries, and each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the first pairs of spaced-apart outer peripheries.

As recited by Claim 43, a method as defined in Claim 42, further comprising positioning an opening in a medial portion of the compact disc, wherein each of the arcuately-extending first pair of spaced-apart outer side peripheries of the portion of the disc are centered about an axis extending through the medial opening and substantially perpendicular to the linearly extending second pair of spaced-apart outer side peripheries, and wherein a radius extending from a medial portion of the medial opening to each of the arcuately-extending first pair of spaced-apart outer side peripheries of the major elevational portion is less than 1.6 inches.

In particular, for example:

(a) Vogelgesang neither teaches nor suggests any method for the formation of an optical disc comprising a pattern of digital data encoded on a surface having a major elevational portion. The Examiner states that Vogelgesang teaches that "The digital data is contained within a major elevational portion once the disk is finished", but fails to cite any such structure or teaching in Vogelgesang. The grooves cited by the Examiner at paragraph 2 of the detailed action, which are described at Column 2, lines 35-36 of Vogelgesang, are conventional grooves and are described as such by Vogelgesang. Such grooves are neither akin nor equivalent to the Applicant's claimed features.

(b) Vogelgesang neither teaches nor suggests any method for the formation of an optical disc wherein a radius extending from a medial portion of the medial opening to each of the arcuately-extending first pair of spaced-apart outer side peripheries of the major elevational portion is less than 1.6 inches. The Examiner states that Vogelgesang teaches a disc having a length of 3.35 in, and hence a diameter of 1.6 in. The disclosure of a diameter of 1.6 in. is neither a teaching nor a suggestion of a diameter of less than 1.6 inches. The Examiner further asserts that "if the digital area of the applied reference were to be extended to cover the entire surface of the card" Applicant's claimed dimension would be obvious over the 1.68 in. diameter taught by Vogelgesang.

However, as is well known to those skilled in the relevant arts, it is highly impractical if not impossible to have a digital data area over the entire surface of the disc. Further, as noted above, Pierson teaches a diameter of less than 1.6 inches and extending only to the periphery of the major elevational section, not to the edge of the disc itself.

(c) Vogelgesang neither teaches nor suggests any method for the formation of an optical disc comprising first and second pairs of spaced-apart outer side peripheries defining outer boundaries of at least portions of the disc, each of the first pair of spaced-apart peripheries arcuately extending between each of the second pair of spaced-apart outer side peripheries, and each of the second pair of spaced-apart outer side peripheries extending substantially linearly between each of the first pairs of spaced-apart outer peripheries. Such limitations, as explained within the specification, are advantageous for, among other benefits, allowing cards according to Applicant's invention to engaged and read by a conventional CD/DVD reader. Vogelgesang neither teaches nor suggests any structure suitable for such purpose. Indeed, at paragraph 2 of the detailed action the Examiner acknowledges that Vogelgesang "envision[s] putting digital data to be read in a rotating reader on a rectangular card", which as one skilled in the relevant arts would understand, would, without structures such as those disclosed and claimed in Applicant's specification, not permit Vogelgesang's cards to be engaged or read by a conventional CD/DVD reader.

Resolution of the level of ordinary skill in the pertinent art

The Examiner has failed entirely to address, much less resolve, the level or types of skill possessed by those of ordinary skill in the pertinent art. Applicant respectfully submits that one of ordinary skill in the arts related to Applicant's claimed methods of forming optical discs would not find it obvious to conceive or implement those methods in view of Vogelgesang or any other cited reference or combination(s) thereof.

Applicant respectfully submits that the Examiner has failed to meet his burden of establishing a *prima facie* case of obviousness with respect to Applicant's claimed inventions.

CONCLUSION

For the reasons shown, Examiner has failed to state a *prima facie* case of obviousness; and it is not possible for him fairly to do so. Applicant respectfully requests reconsideration and withdrawal of the rejection, and allowance of the claims.

Applicant believes that it has fully responded to the Examiner's concerns, and that the claims are in condition for immediate allowance. Applicant requests that any questions concerning this matter be directed to the undersigned at (416) 865-8242.

Applicant believes that no further fees are due in connection with this response. In the event that any such fee is determined by the Office to be due, or any overpayment has been made, Applicant requests that such deficiency or overpayment, including any fee for any Petition connected herewith, be charged to or credited to Deposit Account No. 50-2651.

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Respectfully submitted,



Matthew J. Marquardt
Reg. No. 40,997
TORYS LLP
79 Wellington Street West
Box 270, TD Centre
Toronto, Ontario M5K 1N2
CANADA
(416) 865-8242
Fax: (416) 865-7380